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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/015,967	12/07/2001	Dan L. Eaton	P1447R1	9428
9157	7590	06/03/2005	EXAMINER	
GENENTECH, INC.			JIANG, DONG	
1 DNA WAY			ART UNIT	
SOUTH SAN FRANCISCO, CA 94080			PAPER NUMBER	
			1646	
DATE MAILED: 06/03/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/015,967

Applicant(s)

EATON ET AL.

Examiner

Dong Jiang

Art Unit

1646

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 33-39 and 41-43 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 33-39 and 41-43 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED OFFICE ACTION**

In view of the appeal brief filed on 18 March 2005, the finality of the rejection of the last Office action is withdrawn, PROSECUTION IS HEREBY REOPENED. A new ground of rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

- (1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,
- (2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

Currently, claims 33-39 and 41-43 are pending and under consideration.

#### **Withdrawal of Objections and Rejections:**

The prior art rejection of claim 43 under 35 U.S.C. 103(a) as being unpatentable over Lal et al., WO 200000610-A2 (06 January 2000), and further in view of Capon et al. (US 5,116,964), is withdrawn in view of a new ground of rejection.

#### **Rejections Over Prior Art:**

**The following rejections under 35 U.S.C. § 102 and 103 are made in view of the determination that the effective filing date for the instantly claimed invention is 07 December 2001, which is the actual filing date of the present application, for the reasons set forth in the previous Office Action mailed on 06 June 2003.**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Art Unit: 1646

Claims 33-39, 41 and 42 remain rejected, and *claim 43 is rejected* under 35 U.S.C. 102(b) as being anticipated by Lal et al., WO 200000610-A2 (06 January 2000), for the reasons set forth in the previous Office Action, paper No. 13, mailed on 06 June 2003, at page 6, and for the reasons below.

The rejection of claims 33-39, 41 and 42 made in the previous Office Action (paper No. 13) is reiterated below. Lal discloses a polypeptide, a human signal peptide-containing protein having an amino acid sequence of SEQ ID NO:94, which is 100% identical to SEQ ID NO:2 of the instant invention (see computer printout of the search results). The cited sequence, therefore, anticipates claims 33-39 and 41. Further, Lal teaches a fusion protein comprising said polypeptide and a heterologous moiety (page 39), thus, the reference also anticipates claim 42.

With respect to claim 43, Lal further teaches that the heterologous moiety include GST, MBP, Trx, CBP, 6-His, FLAG, c-myc and HA (page 39, lines 11-13), which are qualified as “an epitope tag”. As such, the reference also anticipates the present claim 43.

Note, applicants arguments regarding the priority of the instant application, and that the prior art reference by Lal et al. is legally insufficient to anticipate the present claims as it does not teach one skilled in the art how to use the disclosed polypeptide have been addressed in the previous Office Actions.

**Conclusion:**

No claim is allowed.


Art Unit: 1646

**Advisory Information:**

Any inquiry concerning this communication should be directed to Dong Jiang whose telephone number is 571-272-0872. The examiner can normally be reached on Monday - Friday from 9:30 AM to 7:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Caputa, can be reached on 571-272-0829. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Dong Jiang, Ph.D.  
Patent Examiner  
AU1646  
5/24/05

  
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